

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	Bartenbach et al.	Docket No.:	54396
Application No.:	10/806,191	Examiner:	BOYER
Filed:	3/23/2004	Art Unit:	1764
Customer No.:	26474	Confirmation No.:	2016

For: Process for carrying out a high-temperature reaction, reactor for carrying out the process, process for the scale-up of a reactor, and use

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

PETITION UNDER 37 C.F.R. § 1.181

Statement of the facts involved: in response to the non-final office action of January 09, 2007, applicants filed a reply including amendments to the claims. In the subsequent Office action of September 05, 2008, the examiner presented new grounds for rejection and made the action final.

Point to be reviewed: whether the examiner erred in making the Office action of September 05, 2008, final.

Action requested: withdraw the finality of the Office action of September 05, 2008.

Remarks: “Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).”¹

¹ MPEP §706.07(a)

First, the rejection was not based on information submitted in an IDS filed during the period set forth in 37 C.F.R. §1.97(c).

Second, the new grounds of rejection were not necessitated by the amendments. The new rejection is presented on page 5, paragraph 18, wherein the Office action states,

“[a]lternatively, claims 8, 10 – 19, and 21 are rejected under 35 U.S.C §103(a) as being unpatentable over Gravley (US 4,765,964) in view of Bakker (US 3,640,739), as evidenced by Voll (Voll et al., “Carbon Black” in: *Ullmann’s Encyclopedia of Industrial Chemistry* (1986 ed.), vol. A5, pp. 144 – 148) and Toombs (US 6,349,678).”

The Toombs reference is newly cited. Toombs is cited only with respect to claims 20 and 21. As explained on page 7, paragraph 27 of the Office action,

[w]ith respect to claims 20 and 21, acetylene is a known product of the partial combustion of methane with oxygen. Thus, Gravley provides an inherent disclosure for a method for the preparation of acetylene by partial oxidation of hydrocarbons using oxygen (see, e.g., Toombs (US 6,349,678), column 1, lines 24 – 37).

The amendment to claim 20 and the presentation of new claim 21 in no way necessitated this new ground of rejection. Prior to the amendment presented in reply to the non-final Office action mailed January 09, 2007, claim 20 read:

The use of a process as claimed in claim 1 or a reactor (1) as claimed in claim 8 for the preparation of acetylene by partial oxidation of hydrocarbons using oxygen.

Claim 20 was split into two claims: claim 20 as amended, and new claim 21. These claims were also reworded to avoid claiming the “use of” a process and the “use of” a reactor. These amendments did not add new matter, and did not necessitate the new ground of rejection.

“Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and

at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.”² It is respectfully submitted that the applicant has not “dallied in the prosecution of [this] application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner ...”³ However, the examiner has added new grounds of rejection in successive actions regarding claims of substantially the same subject matter.

For at least these reasons, it is respectfully submitted that the Office action of September 05, 2008, was improperly made final. Withdrawal of the finality of the Office action of September 05, 2008, is respectfully solicited. In short, applicants respectfully request an opportunity to address the newly cited Toombs reference.

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² MPEP §706.07.

³ MPEP §706.07.